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EXAMINER
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WILLIAMS, ROSS A

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* YOICHI KOBAYASHI, MASATO NAKAMURA,  
HIROSHI UDAGAWA, SATORU UEDA, KOBEI NOJIRI,  
and NAOKI TAKIZAWA

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Appeal 2009-000884  
Application 10/031,282  
Technology Center 3700

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Before ROBERT E. NAPPI, JAY P. LUCAS, and MICHAEL W. O'NEILL,  
*Administrative Patent Judges.*

O'NEILL, *Administrative Patent Judge.*

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

## STATEMENT OF THE CASE

Yoichi Kobayashi et al. (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's decision to finally reject claims 1, 2, 4-9, and 11-27 under 35 U.S.C. § 103(a) as unpatentable over Yoshida<sup>2</sup> (JP 2000-005439, published Jan. 11, 2000) in view of Von Kohorn (US 6,443,840 B2, issued Sep. 3, 2002). We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

### *The Invention*

The invention is to a video game system and service provider system capable of outputting, when a game stage is cleared, privilege information valuable for a player.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A video game system comprising a service provider and a video game device connected through a network, wherein said video game device comprises video game soft program read-out means for reading out a video game soft program from a video game program recording medium, client registration control means for getting access to said service provider through said network and performing client registration of said video game soft program, control means for controlling of progressing a video game in accordance with a video soft program read out by said video game soft program read-out means, getting access to said service provider through said network when the game stage of said video game is cleared, and obtaining privilege information corresponding to the cleared game stage from said service provider, aid printing control means for converting the privilege information obtained

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<sup>2</sup> The Examiner and Appellants incorrectly refer to this reference as "Nippon."

from said service provider into printing data, and outputting the printing data; and

said service provider comprises database administration means for administrating privilege data base in which privilege information corresponding to a game stage of a video game and client data base in which client information of said video game is registered, and distribution control means for controlling of accepting access based on said client information from the video game device connected through said network, taking out privilege information corresponding to the cleared game stage by said database administration means, and distributing said privilege information,

wherein advertisement information is registered by said data base administration means, and said advertisement information is added to said privilege information and distributed by said distribution control means.

## DISCUSSION

### *Pertinent Facts*

#### *Yoshida*

Yoshida relates to a communications game system, i.e., a plurality of game terminals connected to a host computer via communications lines that permits a player to interrupt the game and resume the game at a later time. The host computer stores multiple types of game programs where each game program has an associated identification code. Each game program has a stage identification code for specifying each of the hierarchical stages of the game.

A player playing a game program progresses sequentially through each hierarchical stage. When a player desires to interrupt game play, the player inserts a key card. The game terminal will then write game restart information, i.e., the associated identification code for the game and the stage identification code specifying the hierarchical stage of the game. In

addition to the codes, the key card has other information such as messaging information corresponding to the player's character within the particular game stage. This information provides a collectability aspect similar to a game trading card, e.g., baseball, fantasy role-playing, and the like.

When the player wishes to resume game play later in time, the player inserts the key card into a key card reader attached to the game terminal. The reader reads the stored codes off the card and transmits that information to the host computer. After receiving the codes, the host transmits the game program to the game terminal. The game terminal receives the game program and starts the game at the stage that corresponds to the stage identification code stored on the key card. As a result, the player begins to play the game from the game stage previously interrupted.

*Von Kohorn*

Von Kohorn is directed to the transmission of media broadcasting programs, e.g., television quiz shows, to viewers where the viewers may participate in the broadcasted program by responding to a broadcasted scenario, e.g., for the quiz show, answering the quiz question or wagering on a possible outcome of a contestant answering the quiz question. Von Kohorn describes the equipment at both the central station, e.g. the television broadcast studio, and the remote receiving station, e.g., a viewer's response unit located at the viewer's home, in order for the viewer to participate in the broadcast and receive any reward from such participation.

Since an objective of Von Kohorn is to attract viewers to the broadcasted program, Von Kohorn further describes a beneficial aspect of having a captured audience, namely, presenting advertising material. The Von Kohorn system is capable of providing "hard copy" records, such as

coupons, in conjunction with any prize information obtained, to a viewer via transmitting a set of instructional signals to a viewer's remote unit in order for the remote unit to print out the material, e.g., coupons, rewards, promotional materials, and the like.

### *Analysis*

After reviewing the positions articulated in Appellants' Briefs and the Examiner's Answer and our review of Yoshida and Von Kohorn summarized *supra*; in our view, the Examiner's rejection of the claims on appeal is based on improper hindsight reconstruction gleaned from viewing Appellants' Specification and reading the claims, and not on a reason with some rational underpinnings for combining Yoshida and Von Kohorn. Yoshida is directed to permitting players to stop game play at a particular stage in a game and then permitting the players to continue at that game stage instead of starting back from the beginning game stage. Von Kohorn is directed to permitting viewers (players) to participate in a broadcasted game and receive both rewards and advertising material. Von Kohorn appears not to be interested in permitting players to interrupt game play in order to return to the point of interruption. The Examiner has provided no evidence or reasoning that Yoshida appears interested in presenting advertising information to a player on the key card.

Accordingly, this case is not seen as being an obvious combination of prior art elements or a simple substitution of one known element for another, leading to predictable results, or any other indicator of potential obviousness. Rather the extensive amount of modification needed is suggested nowhere in the cited art or by the Examiner, and is born from the

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use of impermissible hindsight reconstruction in view of Appellants' Specification and reading of the claims on appeal.

Moreover, even if Yoshida and Von Kohorn are combined as the Examiner proffers in the rejection (adding advertisement information to privilege information), we agree with the Appellants' contention that the combination of Yoshida and Von Kohorn still fails to render obvious the claimed feature of the combined advertisement and privilege information being distributed by either a distribution control means (claims 1, 2, 4-9, 11-18) or service provider (claim 19-27), as set forth in the claims.

#### DECISION

In view of the foregoing, the Examiner's decision to reject the claims as obvious over Yoshida and Von Kohorn is reversed.

#### REVERSED

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